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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/690,717	10/22/2003	Jonathan S. Stinson	10527-501001	9775
26161	7590	10/10/2006		
FISH & RICHARDSON PC P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022				
			EXAMINER MORILLO, JANEL COMBS	
			ART UNIT	PAPER NUMBER

1742

DATE MAILED: 10/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/690,717	<b>Applicant(s)</b> STINSON, JONATHAN S.	
	<b>Examiner</b> Janelle Combs-Morillo	<b>Art Unit</b> 1742	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 13 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1,3-27,29-33,35,36,41 and 44-62 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,3-27,29-33,35,36,41 and 44-59 is/are allowed.
- 6) ☒ Claim(s) 60-62 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 60-62 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 61-076634 (JP'634) in view of Matsui.

JP'634 teaches a Pt alloy used for medical equipment and accessories (see Derwent abstract), wherein said alloy comprises (in wt%): 0.1-5% Ru, 2-15% Fe, Cr, and Co (abstract), which overlaps the ranges of Pt, Cr, Fe in instant claims 60-62. JP'634 further teaches an example with 2% Fe, 5% Cr, 3% Ru, and 90% Pt (see p 196, ex. e), which falls within the claim ranges of Fe, Cr, and Pt of instant claim 61. JP'634 does not mention Mo is present.

However, Matsui teaches 0.1-10at% Mo can be added to similar Pt alloys in order to shorten the solution heat treatment time (column 3 lines 28-31). It would have been obvious to one of ordinary skill in the art to add Mo to the Pt-Cr-Fe alloy used for medical equipment taught by JP'634 because Matsui teaches Mo can be added to similar Pt alloys in order to shorten the solution heat treatment time.

Concerning the presence of Fe, Cu, Mn, Ni, P, Si, N, S, and C as mentioned by instant claim 62, the marginal presence of said elements is held to be within the order of ppm as a impurity of Pt, Cr, or Mo. Because the instant claims do not recite an amount of said elements,

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wherein said amount is clearly outside the expected impurity level for Pt, Cr, and/or Mo, then the alloy taught by the combination of JP'634 and Matsui is held to meet said limitation.

Concerning amended claims 60, it would have been obvious to one of ordinary skill in the art to form a variety of medical instruments or devices from the alloy taught by JP'634, such as scissors, needle, scalpel, etc., because JP'634 teaches said high corrosion oxidation resistant platinum alloy is formed into medical equipment (abstract).

When a prima facie case is established, the burden shifts to applicant to come forward with rebuttal evidence or argument to overcome the prima facie case. See, e.g., Bell, 991 F.2d at 783-84, 26 USPQ2d at 1531; Rijckaert, 9 F.3d at 1532, 28 USPQ2d at 1956; Oetiker, 977 F.2d at 1445, 24 USPQ2d at 1444.

***Allowable Subject Matter***

3. Claims 1, 3-27, 29-33, 35-36, 41, 44-59 are allowable over the prior art of record (see Office action mailed June 24, 2005).

***Response to Amendment***

4. In the response filed on July 13, 2006 applicant amended claims 12, 50, 60-62, canceled claim 63, and submitted various arguments traversing the rejections of record. The examiner agrees that no new matter has been added.

5. Applicant has overcome the claim objection to claims 12 and 50.

6. Applicant's argument that the present invention is allowable over the prior art of record because the prior art does not teach the specific medical devices listed in amended claims 60-62 has not been found persuasive. As stated above, it would have been obvious to one of ordinary

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skill in the art to form a variety of medical instruments or devices from the alloy taught by JP'634, such as scissors, needle, scalpel, etc., because JP'634 teaches said high corrosion oxidation resistant platinum alloy is formed into medical equipment (abstract).

### *Conclusion*

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janelle Combs-Morillo whose telephone number is (571) 272-1240. The examiner can normally be reached on 8:30 am- 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (571) 272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ROY KING   
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700

JCM   
September 27, 2006